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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,786	03/15/2004	Jose Madeira De Freitas Garcia	G&C 30566.321-US-01	9206
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GATES & COOPER LLP HOWARD HUGHES CENTER 6701 CENTER DRIVE WEST, SUITE 1050 LOS ANGELES, CA 90045			EXAMINER ORR, HENRY W	
			ART UNIT	PAPER NUMBER
			2176	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/800,786

Applicant(s)

GARCIA ET AL.

Examiner

Henry Orr

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) * | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) * | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/20/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to application communication filed March 15, 2004;
2. Claims 1-15 are pending in the case. Claims 1, 6, and 11 are independent claims.

Information Disclosure Statement

3. The information disclosure statement (IDS) submitted on January 20, 2005 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner is considering the information disclosure statement.

Specification

4. The disclosure is objected to because of the following informalities:
 - a) According to Fig. 7, "**Block 702**" should be replaced with "**Block 704**" on p. 17 line 16.
 - b) "**Block 702**" should be added to specification on p. 17 within the 11.3 Views section to accurately reflect the description of the display view feature of Block 702 in Fig. 7.

Appropriate corrections are required.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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6. **Claims 11-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The language of the claims raises a question as to whether the claims are directed merely to abstract ideas that are not tied to a technological art, environment, or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101. Claims considered to be Non-functional Descriptive Material are not statutory even if in combination with a physical medium. see MPEP § 2106**

Regarding claims 11-15, the phrase “**article of manufacture**” is intended to cover a signal as disclosed in the specification (p. 6 lines 8-11). Claiming a signal per se is considered non-statutory subject matter because a signal is a form of energy.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. **Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Independent claims 1, 6, and 11, recite the phrase “**the Sheet Set Manager**”. There is insufficient antecedent basis for this limitation in the claims because “**the Sheet Set Manager**” has not been previously recited.

Dependent claims 5, 10, and 15, recite the phrase “**each Sheet**”. There is

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insufficient antecedent basis for this limitation in the claims because it is unclear whether **“each Sheet”** is referring back to **“the Sheet”** as recited in the respective base claims.

Dependent claims 2-5, 7-10, and 12-15 are rejected for fully incorporating the deficiencies of their respective base claims.

Double Patenting

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 1-15 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-33 of copending

Application # 10/800585.

Although conflicting claims 1, 6 and 11 of instant application and claims 1, 12 and 23 of co-pending application # 10/800585 are not identical, the respective claims are not patentably distinct from each other because the instant claims recite similar features. However, claim 1 of copending application # 10/800585 recites the limitation “**Sheet Set Manager manages one or more different views for the Sheets**”, which is an obvious variation of limitation “**Sheet Set Manager publishes the Sheet Set**” recited in claim 1 of the instant application.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the Sheet Set Manager function of the co-pending application # 10/800585 because the views of the Sheet Set must be made known to the user or published on the user computer in order for the usefulness for managing the views of the Sheet Set to be realized.

Claims 6 and 11 are substantially encompassed in claim 1 above, therefore the claims are rejected under the same rationale as claim 1 above in respect to claims 12 and 23 of the copending Application #10/800585.

Dependent claims 2-5, 7-10 and 12-15 are rejected for fully incorporating the deficiencies of their respective base claims.

11. Claims 1-15 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-21 of copending Application # 10/800877.

Although conflicting claims 1, 6 and 11 of instant application and claims 1, 8 and 15 of co-pending application # 10/800877 are not identical, the respective claims are not patentably distinct from each other because the instant claims recite similar features. However, claim 1 of copending application # 10/800877 recites the limitation “**Sheet Set Manager displays a logical structure for the Sheet Set, Subsets, and Sheets on the computer**”, which is an obvious variation of limitation “**Sheet Set Manager publishes the Sheet Set**” recited in claim 1 of the instant application.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the Sheet Set Manager function of the co-pending application # 10/800877 because displaying a logical structure for the Sheet set involves making the Sheet Set known to the user or publishing to the user so that the usefulness for managing the logical structure for the Sheet Set will be realized.

Claims 6 and 11 are substantially encompassed in claim 1 above, therefore the claims are rejected under the same rationale as claim 1 above in respect to claims 8 and 15 of the copending Application #10/800877.

Dependent claims 2-5, 7-10 and 12-15 are rejected for fully incorporating the deficiencies of their respective base claims.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1, 2, 5-7, 10-12 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bonney et al. (hereafter referred to as Bonney), U.S. Patent # 6,466,953 B1 of record, in view of Takahashi et al. (hereafter referred to as Takahashi), U.S. Patent # 6,339,439 B1, in further view of Matthews et al. (hereafter referred to as Matthews), U.S. Patent # 7,047,180 B1.

The applied Bonny and Matthews references have a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the references, they constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the references was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the references, prior to the effective U.S. filing date of the references under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and references are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the references are disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

Regarding claim 1, Bonney teaches **"Drawings, in general, may include many**

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details of the models such as, but not limited, alternate views, section views, detail views of certain aspects of each of the models” (col. 1 lines 26-30). (claim 1; i.e., wherein the Sheet Set Manager manages a one or more Sheet Sets, each of the Sheet Sets comprises a collection of zero or more Sheets and Subsets of the Sheets, each of the Sheets comprises a drawing, layout or view) Examiner considers the drawings to be a set of drawing sheets and the section views to be subsets of the sheets.

Bonny does teach a graphic program such as a computer aided design application program (Bonney; abstract). Bonney does not expressly teach performing a Sheet Set Manager function in a graphics program. However, Takahashi teaches “**a logical planes (hereinafter referred to as sheets)” (col. 1 lines 12-14).** Takahashi further teaches “**a display plane generating function etc...a derivative display plane generating function etc...a logical display plane displaying function etc...” (col. 5 lines 15-30).** Examiner considers the different logical plane functions as sheet functions for managing sets of logical plane sheets.

In the same field of endeavor, the relationship between drawing sheets is managed (Bonney; col. 1 lines 50-52). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Bonny’s application 220 of Figure 2 to include the sheet set functions as taught by Taskahashi because the intent of Bonny invention was to accurately manage and use the drawings sheets (Bonney; col. 1 lines 48-50). Thus, for the purpose of managing the drawings, a Sheet Set Manager Function would have been created from the sheet set functions. (claim 1;

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i.e., performing a Sheet Set Manager function in the graphics program)

Bonney also does not expressly teach publishing a Sheet Set. However, Matthews teaches **"Web site administrators can use the present invention to dynamically index and publish design drawing data" (abstract)**. (claim 1; i.e., the Sheet Set Manager publishes the Sheet Set.) Examiner considers the design drawing data to cover a design drawing sheet data set.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to convert the CAD drawings generated by Bonney's computer aided program into a drawing web format to be published using a web server as taught by Matthews and to be displayed using the sheet set functions as taught by Takahashi to provide the benefit of multiple users accessing the drawings from geographically diverse sites. (Matthews; col. 1 lines 50-58, col. 2 lines 44-65)

Regarding claim 2, Bonney does not expressly teach publishing a selection of Sheets within the Sheet Set using a single operation. However, Matthews teaches **"To view the specific drawing in more detail, the user merely selects or clicks on the desired drawing or hyperlink etc... Such options may be accessible by clicking the right mouse button while the cursor is over the image" (col. 8 lines 6-34)**. (claim 2; i.e., wherein the Sheet Set Manager publishes a selection of the Sheets within the Sheet Set using a single operation.) Examiner considers the clicking of right mouse button as a single operation.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to convert the CAD drawings generated by Bonney's computer

aided program into a drawing web format and to publish using a web server as taught by Matthews, and using the sheet set functions as taught by Takahashi to display a selection of drawings using the clicking of a right mouse button as taught by Matthews to provide the benefit for the user to view specific drawings in more detail. (Matthews; col. 8 lines 6-15)

Regarding claim 5, Bonney does not expressly teach to include a plot stamp with each Sheet of the published Sheet Set. However, Matthews teaches **"Additional display regions may contain further information relating to the drawing (e.g., the title, subject, author, keywords, comments, size, creation date, modification date, last access date, and file attributes)"** (col. 8 lines 38-41). (claim 5; i.e., wherein the Sheet Set Manager includes a plot stamp with each Sheet of the published Sheet Set.) Examiner considers the display region of information to be a plot stamp because the information describes the drawing just like a label of a plot stamp.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to convert the CAD drawings generated by Bonney's computer aided program into a drawing web format to be published including a plot stamp information in a display region as taught by Matthews and to display using the sheet set functions as taught by Takahashi to provide the benefit of providing further specific details to multiple users accessing the drawings from geographically diverse sites so that the users can monitor the changes to the drawings (Matthews; col. 1 50-59, Figure 7).

Claims 6, 7 and 10 are directed towards an apparatus and are substantially

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encompassed in method claims 1, 2 and 5, respectfully; therefore the apparatus claims are rejected under the same rationale as method claims 1, 2 and 5 above. It would have been obvious to one of ordinary skill in the art at the time the invention was made to configure the apparatus of Bonney's Figure 2 because the apparatus is capable of operating a graphic program such as a computer aided design application program to perform the limitations as recited in apparatus claims 6, 7 and 10 as further explained under the rationale of method claims 1, 2 and 5 above.

Claims 11, 12, and 15 are directed towards manufacture claims and are substantially encompassed in method claims 1, 2 and 5, respectfully; therefore the manufacture claims are rejected under the same rationale as method claims 1, 2 and 5 above. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the application program of Bonney's Figure 2 because the application program is capable of embodying logic for operating like a graphic program such as a computer aided design application program to perform the limitations as recited in manufacture claims 11, 12, and 15 as further explained under the rationale of method claims 1, 2 and 5 above. (Bonney; col. 4 lines 1-5)

14. Claims 3, 4, 8, 9, 13, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bonney, in view of Takahashi, in further view of Matthews as cited and applied to claim 1 above, and in further view of Haddad, U.S.

Publication # 2002/0111928 A1.

Regarding claim 3, neither Bonney or Matthews expressly teach applying

publishing override properties for the Sheets. However, Haddad teaches **"Fig. 9C illustrates a graphical user interface screen for editing print settings for a selected document set etc...Parameters related to the print media are entered by the user in the sheet definitions fields 932"** (p. 7 par. 91). (claim 3; i.e., wherein the Sheet Set Manager applies publishing overrides to the published Sheet Set, thereby changing a plurality of publishing properties for the Sheets.) Examiner considers the print settings entered by the user for a printing work order to override any default publishing printing properties at a reprographic company that receive the printing work order for the drawing sheets.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to convert the CAD drawings generated by Bonney's computer aided program into a drawing web format to be published using a web server as taught by Matthews to be displayed using the sheet set functions as taught by Takahashi and to modify the application program in Bonney's Figure 2 to include a graphical user interface for print settings as taught by Haddad to provide the benefit of properly applying a print specification to a drawing document in an efficient manner. (Bonney; Figure 2) (Matthews; col. 1 lines 50-58, col. 2 lines 44-65) (Haddad; p. 1 par. 4-5)

Regarding claim 4, neither Bonney or Matthews expressly teach allowing different elements of the published Sheet Set to be sent to different output devices. However, Haddad teaches **"one or more repro companies can be selected to produce the print work order"** (p. 7-8 par. 93). (claim 4; i.e., wherein the Sheet Set Manager allows different elements of the published Sheet Set to be sent to different

output devices.) Examiner considers the repro companies to be capable of printing the applicable documents or files (Haddard; p. 4 par. 51). Therefore, the different repro companies listed in the graphical interface of Haddard Figure 11 have their own individual output device, which allows a user to send print work orders associated with drawing sheets to the different repro companies having their own printing output device.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to convert the CAD drawings generated by Bonney's computer aided program into a drawing web format to be published using a web server as taught by Matthews to be displayed using the sheet set functions as taught by Takahashi and to modify the application program in Bonney's Figure 2 to include a graphical user interface for repro companies as taught by Haddad to provide the benefit of efficiently producing and distributing printed documents. (Bonney; Figure 2) (Matthews; col. 1 lines 50-58, col. 2 lines 44-65) (Haddad; p. 1 par. 9-11)

Claims 8 and 9 are directed towards an apparatus and are substantially encompassed in method claims 3 and 4 respectfully; therefore the apparatus claims are rejected under the same rationale as method claims 3 and 4 above. It would have been obvious to one of ordinary skill in the art at the time the invention was made to configure the apparatus of Bonney's Figure 2 because the apparatus is capable of operating a graphic program such as a computer aided design application program to perform the limitations as recited in apparatus claims 8 and 9 as further explained under the rationale of method claims 3 and 4 above.

Claims 13 and 14 are directed towards manufacture claims and are substantially

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encompassed in method claims 3 and 4, respectfully; therefore the manufacture claims are rejected under the same rationale as method claims 3 and 4 above. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the application program of Bonney's Figure 2 because the application program is capable of embodying logic for operating like a graphic program such as a computer aided design application program to perform the limitations as recited in manufacture claims 13 and 14 as further explained under the rationale of method claims 3 and 4 above. (Bonney; col. 4 lines 1-5)

Conclusion

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Henry Orr whose telephone number is (571) 274 1308. The examiner can normally be reached on Monday thru Friday 8 to 4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jackson can be reached on (571) 270 1279. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Henry Orr
Examiner
Art Unit 2197

12/28/2006
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PRIMARY EXAMINER